

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Rivest et al.

Application No.: 10/553,611

Confirmation No.: 1989

Filed: January 8, 2008

Art Unit: 2131

For: MICROPAYMENT PROCESSING METHOD
AND SYSTEM

Examiner: Not Yet Assigned

REQUEST FOR CLARIFICATION:
DECISION ON PETITION UNDER 37 C.F.R. §§ 1.47(A) / 1.181

MS PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Rafael Bacares

Sir:

Applicants request clarification regarding the Decision on Petition under 37 C.F.R § 1.47(a) dated 07 May 2008. Page 1, paragraph 6 of the Decision states, "Consequently, the current record does sufficiently establish Dr. McDonald [*sic*] refusal to join in the application."

Applicants hereby request clarification regarding Dr. McDonald's relationship to this application and note that this statement appears to have been included unintentionally.

Also, applicants note that the application status on PAIR is listed as "Abandoned -- Incomplete Application (Pre-examination)." Applicants hereby request

correction of the application status based on the Decision on Renewed Petition under 37 C.F.R. §§ 1.47(a) / 1.181 dated 28 February 2008. In the 28 February 2008 decision, the petition under 37 C.F.R. § 1.181 was granted and the Notice of Abandonment was vacated.

Please charge any underpayment or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 401768005US2 from which the undersigned is authorized to draw.

Dated: October 30, 2008

Respectfully submitted,

By 

Kellie S. Bickel

Registration No.: 46,386

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Attorney for Applicant

Enclosure:

Decision on Petition under 37 C.F.R § 1.47(a) dated 07 May 2008

Decision on Renewed Petition under 37 C.F.R §§ 1.47(a) / 1.181 dated 28 Feb 2008



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Stephen E. Arnett
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In re Application of : DECISION ON
Rivet et al :
PCT No.: PCT/US04/01845 :
Application No: 10/553,611 : PETITION UNDER
Int. Filing Date: 23 January 2004 :
Priority Date: 25 January 2005 :
Attorney's Docket No.: 67065-037 (PEPL-0112) : 37 CFR 1.47(a)
For: MICROPAYMENT PROCESSING :
METHOD AND SYSTEM :

This is in response to the "SECOND RENEWED PETITION UNDER 37 C.F.R.
§1.47(a)" filed on 24 April 2008.

BACKGROUND

In a decision from this Office on 27 February 2008, the renewed petition under 37 CFR 1.47(a) was dismissed. The decision stated that item (2) had not been satisfied.

On 24 April 2008, petitioner submitted a "Second Renewed Petition Under 37 CFR 1.47(a), which included a declaration by Kellie S. Bickel"

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The renewed petition of 24 April 2008 has satisfied item (2) under 37 CFR 1.47(a) because the averments of Kellie Bickel sufficiently demonstrate that a *bona fide* attempt was made to obtain the signatures of nonsigning inventors Perry Solomon and Robert Carney and that they have refused to sign the declaration.

Consequently, the current record does sufficiently establish Dr. McDonald refusal to join in the application.

Petitioner has now satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **08 January 2008**.



Rafael Bacares

PCT Legal Examiner

PCT Legal Office

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07 MAY 2008



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Mr. Robert Carney
15 Newman Street
Cambridge, Massachusetts, 02140

In re Application of
Rivet et al
PCT No.: PCT/US04/01845
Application No: 10/553,611
Int. Filing Date: 23 January 2004
Priority Date: 25 January 2005
Attorney's Docket No.: 67065-037 (PEPL-0112)
For: MICROPAYMENT PROCESSING
METHOD AND SYSTEM

Dear Mr. Carney:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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07 MAY 2008



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Mr. Perry Solomon
111 85th Street E#17G
New York, New York, 10028

In re Application of
Rivet et al
PCT No.: PCT/US04/01845
Application No: 10/553,611
Int. Filing Date: 23 January 2004
Priority Date: 25 January 2005
Attorney's Docket No.: 67065-037 (PEPL-0112)
For: MICROPAYMENT PROCESSING
METHOD AND SYSTEM

Dear Mr. Solomon:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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27 FEB 2008



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In re Application of	:	DECISION ON RENEWED
Rivet et al	:	
PCT No.: PCT/US04/01845	:	
Application No: 10/553,611	:	PETITION UNDER
Int. Filing Date: 23 January 2004	:	
Priority Date: 25 January 2005	:	
Attorney's Docket No.: 67065-037 (PEPL-0112)	:	37 CFR 1.47(a)/ 1.181
For: MICROPAYMENT PROCESSING	:	
METHOD AND SYSTEM	:	

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)," filed on 08 January 2008.

BACKGROUND

In a decision from this Office on 08 June 2007, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that items (1)-(4) under 37 CFR 1.47(a) were not met, and the decision set a time period of response of two (2) months and extensions of time were available under 37 CFR 1.136(a).

On 05 December 2007, the United States Patent and Trademark Office mailed a "NOTICE OF ABANDONMENT" stating that the above-identified application is abandoned for failure to timely reply to the Decision on Petition mailed on 06/08/2007.

On 08 January 2008, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a) and Petition to Withdraw Holding of Abandonment under 37 CFR 1.181(a)" requesting reconsideration of the Office's decision of 08 June 2007, and to withdraw the abandonment mailed on 05 December 2007.

DISCUSSION

PETITION UNDER 37 CFR 1.181:

A review of the filed reveals that petitioner had time to response to the Decision mailed on 08 June 2007, and that petitioner's response on 08 January 2008 accompanied by a petition for a five-month extension time is timely.

The renewed petition under 37 CFR 1.47(a) is timely.

The petition under 37 CFR 1.181 is GRANTED. The Notice of Abandonment mailed on 05 December 2007 was in error and is hereby VACATED.

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The renewed petition satisfies requirements (1), (3), and (4) under 37 CFR 1.47(a) but not item (2).

Regarding requirement (1), petitioner has provided the complete fee of \$200.00 under 37 CFR 1.17(g).

With respect to requirement (2), although the averments of Ms. Kellie S. Bickel and the signed postal receipts are sufficient to support a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventors for their signatures, the time period for their responses before filing the petition was too short. The application papers were mailed on December 18, 2007 and received on December 22, 2007 and December 27, 2007 by Mr. Gione and Mr. Carney, respectively but the renewed petition was filed on 08 January 2008 (less than a month for the nonsigning inventors to read, and decide to whether to respond). In fact, an email from Perry Solomon on December 21, 2007 states that the "end of year is very busy time." Accordingly, this is a short time period (about two weeks) to make a determination that they refuse to sign the papers.

With respect to requirement (3), a statement of the last known address of the missing inventors have been provided.

- (i) Perry Solomon
111 85th Street E #17G
New York, New York 10028
- (ii) Robert Carney
15 Newman Street
Cambridge, Massachusetts 02140

Regarding requirement (4), petitioner has provided an executed declaration signed by Ronald L. Rivest, Silvio Micali, Robert Nix, Prasad Jonnalagadda, Joseph Bergeron iii and Mark Bates on their behalf and on the behalf of the nonsigning joint inventors Perry Solomonmon and Robert Carney.

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).


CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.181 is **GRANTED**.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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